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10/730,228

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Ronald P. Akialis JR.

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EXAMINER

JOHNSON, GREGORY L

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/730,228	Applicant(s) AKIALIS ET AL.	
	Examiner GREGORY JOHNSON	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to the amendment filed April 21, 2008.

Status of Claims

2. Claims 1, 7, 13-16 and 18-20 are amended. Claims 2-6, 8-12, 17 and 21-25 are as previously presented. Claims 26-30 are new. Claims 1-30 are pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-4, 7-8, 10, 12-15, 20-22, 24 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne et al., Pub. No. 2003/0229590 (hereinafter Byrne), in view of Stewart et al., Pub No. 2002/0120846 (hereinafter Stewart), Friedman

et al., Pub. No. 2003/0208556 (hereinafter Friedman) and Whitaker et al., Pub. No. 2004/0148203 (hereinafter Whitaker).

As to claim 1-4, 7-8, 10, 12-15, 20-22 and 24, Byrne and Stewart discloses and teaches the invention substantially as claimed as set forth in the Office Action mailed on March 10, 2008.

Applicants amended claims 1, 13-15 and 20 to include the following new limitation:

- and where said electronic notification is formatted in a familiar and recognizable format of the biller such that the electronic notification appears to the consumer as if generated by the biller.

Neither Byrne nor Stewart discloses or teaches this new limitation.

However, Friedman teaches a method and apparatus for electronic commerce in which a web server is able to present to a network user a web page (i.e. electronic document) that appears to be an extension of the web site from which the network user was recently connected to. The web server is able to emulate the "look and feel" of a vendor's web page by maintaining in a database, a client identifier and data identifying the appropriate backgrounds, color schemes, font sizes, font styles, font colors, logos, and other graphic or sonic elements etc. which emulate the look and feel of the client web site and give the network user the impression that he/she is still connected to the vendor's web site. Friedman also teaches that the web server and an email server can

be implemented with applications which execute on the same computer system (i.e. a single computer system performs the functions of a web server and an email server; ¶0058 and ¶0071).

It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to include in the global integrated payment system as disclosed by Byrne, the method of transmitting to a user an electronic document (i.e. web page) that gives the user the impression that the document was transmitted by the vendor as taught by Friedman, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in that art would have recognized that the results of the combination were predictable. See MPEP 2143 (Rev. 6, Sept 2007).

It would also have been obvious to one of ordinary skill in the art at the time of Applicants' invention to include in the global integrated payment system as disclosed by Byrne, the method of using one computer system (e.g. email and web server) to transmit to a user an electronic document that gives the user the impression that the document was transmitted by the vendor as taught by Friedman. It is obvious that the computer system disclosed by Friedman could as easily produce an email message using the same identifying vendor data to make it appear that the email was produced by the vendor. It is obvious that a simple substitution of one known element for another (electronic document: web page vs. email message) would produce a predictable result. See MPEP 2143 (Rev. 6, Sept 2007).

As to claims 7 and 26-28, neither Byrne, Stewart nor Friedman discloses or teaches the following limitation:

- first pre-authorizing a given customer and a given of validating a credit or debit card to be used for payment based on cardholder information and sending information of said pre-authorization validation to said biller prior to receipt of any a specific request for authorization of a specific payment charged to said card from a consumer so as to allow a biller to determine the validity, of the card prior to proceeding with a transaction.

However, Whitaker teaches a method for transmitting from a financial transaction processing computer system authorization information. Whitaker teaches point-of-sale (POS) devices are widely used by merchants and service providers to pre-authorize credit card payments. Upon being presented with a credit card for payment, a service provider, such as a doctor, enters information from the credit card into a POS. In one well-known example of a credit card pre-authorization process, the service provider also enters the amount of the bill into the POS device. Information is then transmitted from the POS, through a credit card processing network, to a credit card processing host computer system. The host computer system uses the information to validate the credit card account number, verify that the amount does not exceed the cardholder's spending limit, confirm that the card has not been reported stolen, and the like. In response, the host computer system transmits to the POS an approval code that appears on a display screen of the POS. The approval code provides the service provider further confidence that the service provider will receive payment for the services (§0016).

It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to include in the global integrated payment system as disclosed by Byrne, the credit card pre-authorization process as taught by Whitaker, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in that art would have recognized that the results of the combination were predictable. See MPEP 2143 (Rev. 6, Sept 2007).

6. Claims 5-6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne and Stewart as applied to claim 1 above, and further in view of Ensel et al., Pat. No. 6,493,685 (hereinafter Ensel) as set forth in the Office Action filed on July 5, 2007.

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne and Stewart as applied to claim 1 above, and further in view of Mersky et al., Pat. No. 6,119,106 (hereinafter Mersky) as set forth in the Office Action filed on July 5, 2007.

8. Claims 16-17 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne, in view of Stewart, Lewis et al., Pub. No. 2002/0029194 (hereinafter Lewis) and Whitaker.

As to claims 16-17, Byrne and Stewart discloses and teaches the invention substantially as claimed as set forth in the Office Action mailed on March 10, 2008.

As to claim 29, neither Byrne, Stewart nor Lewis discloses or teaches the following limitation:

- first pre-authorizing a given customer and a given of validating a credit or debit card to be used for payment based on cardholder information and sending information of said pre-authorization validation to said biller prior to receipt of any a specific request for authorization of a specific payment charged to said card from a consumer so as to allow a biller to determine the validity, of the card prior to proceeding with a transaction.

However, Whitaker teaches a method for transmitting from a financial transaction processing computer system authorization information. Whitaker teaches point-of-sale (POS) devices are widely used by merchants and service providers to pre-authorize credit card payments. Upon being presented with a credit card for payment, a service provider, such as a doctor, enters information from the credit card into a POS. In one well-known example of a credit card pre-authorization process, the service provider also enters the amount of the bill into the POS device. Information is then transmitted from the POS, through a credit card processing network, to a credit card processing host computer system. The host computer system uses the information to validate the credit card account number, verify that the amount does not exceed the cardholder's spending limit, confirm that the card has not been reported stolen, and the like. In response, the

host computer system transmits to the POS an approval code that appears on a display screen of the POS. The approval code provides the service provider further confidence that the service provider will receive payment for the services (§0016).

It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to include in the global integrated payment system as disclosed by Byrne, the credit card pre-authorization process as taught by Whitaker, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in that art would have recognized that the results of the combination were predictable. See MPEP 2143 (Rev. 6, Sept 2007).

9. Claims 18-19 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne, in view of Stewart, Mersky, Friedman and Whitaker.

As to claims 18-19, Byrne, Stewart and Mersky discloses and teaches the invention substantially as claimed as set forth in the Office Action mailed on March 10, 2008.

Applicants have amended claims 18-19 to include the following new limitations:

- and where said electronic notification is formatted in a familiar and recognizable format of the biller such that the electronic notification appears to the consumer as if generated by the biller; and

- sending an e-mail to the payor that the payment has been authorized, said e-mail is formatted in a familiar and recognizable format of the biller such that the e-mail appears to the consumer as if generated by the biller.

Neither Byrne, Stewart nor Mersky discloses or teaches this new limitation.

However, Friedman teaches a method and apparatus for electronic commerce in which a web server is able to present to a network user a web page (i.e. electronic document) that appears to be an extension of the web site from which the network user was recently connected to. The web server is able to emulate the "look and feel" of a vendor's web page by maintaining in a database, a client identifier and data identifying the appropriate backgrounds, color schemes, font sizes, font styles, font colors, logos, and other graphic or sonic elements etc. which emulate the look and feel of the client web site and give the network user the impression that he/she is still connected to the vendor's web site. Friedman also teaches that the web server and an email server can be implemented with applications which execute on the same computer system (i.e. a single computer system performs the functions of a web server and an email server; ¶0058 and ¶0071).

It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to include in the global integrated payment system as disclosed by Byrne, the method of transmitting to a user an electronic document (i.e. web page) that gives the user the impression that the document was transmitted by the vendor as taught by Friedman, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same

function as it did separately, and one of ordinary skill in that art would have recognized that the results of the combination were predictable. See MPEP 2143 (Rev. 6, Sept 2007).

It would also have been obvious to one of ordinary skill in the art at the time of Applicants' invention to include in the global integrated payment system as disclosed by Byrne, the method of using one computer system (e.g. email and web server) to transmit to a user an electronic document that gives the user the impression that the document was transmitted by the vendor as taught by Friedman. It is obvious that the computer system disclosed by Friedman could as easily produce an email message using the same identifying vendor data to make it appear that the email was produced by the vendor. It is obvious that a simple substitution of one known element for another (electronic document: web page vs. email message) would produce a predictable result. See MPEP 2143 (Rev. 6, Sept 2007).

As to claim 30, neither Byrne, Stewart, Mersky nor Friedman discloses or teaches the following limitation:

- first pre-authorizing a given customer and a given of validating a credit or debit card to be used for payment based on cardholder information and sending information of said pre-authorization validation to said biller prior to receipt of any a specific request for authorization of a specific payment charged to said card from a consumer so as to allow a biller to determine the validity, of the card prior to proceeding with a transaction.

However, Whitaker teaches a method for transmitting from a financial transaction processing computer system authorization information. Whitaker teaches point-of-sale (POS) devices are widely used by merchants and service providers to pre-authorize credit card payments. Upon being presented with a credit card for payment, a service provider, such as a doctor, enters information from the credit card into a POS. In one well-known example of a credit card pre-authorization process, the service provider also enters the amount of the bill into the POS device. Information is then transmitted from the POS, through a credit card processing network, to a credit card processing host computer system. The host computer system uses the information to validate the credit card account number, verify that the amount does not exceed the cardholder's spending limit, confirm that the card has not been reported stolen, and the like. In response, the host computer system transmits to the POS an approval code that appears on a display screen of the POS. The approval code provides the service provider further confidence that the service provider will receive payment for the services (§0016).

It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to include in the global integrated payment system as disclosed by Byrne, the credit card pre-authorization process as taught by Whitaker, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in that art would have recognized that the results of the combination were predictable. See MPEP 2143 (Rev. 6, Sept 2007).

10. Claims 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne and Stewart as applied to claim 20 above, and further in view of Mersky as set forth in the Office Action filed on July 5, 2007.

Response to Arguments

11. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY JOHNSON whose telephone number is (571) 272-2025. The examiner can normally be reached on Monday - Friday, 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ALEXANDER KALINOWSKI can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alexander Kalinowski/
Supervisory Patent Examiner, Art Unit 3691

GREGORY JOHNSON
Examiner, Art Unit 3691